

REMARKS

The last Office Action has been carefully considered.

It is noted that claim 13 is rejected under 35 U.S.C. 103 over the patent to Delf.

Claim 15 is rejected under 35 U.S.C. 103 over the patent to Delf.

Claim 21 is rejected under 35 U.S.C. 103(a) over the patent to Delf in view of the patent to Savage.

Claim 14 is rejected for formal reasons.

In connection with the Examiner's formal rejection of claim 14, this claim has been amended.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants have retained claim 13, the broadest claim on file, as it was. At the same time, claims 15 and 18 have been canceled and new claims 26 and 27 have been added which contain the subject matter of the original claims 13, 15 and 13, 18.

It is respectfully submitted that the present invention as defined in the claims clearly and patentably distinguishes from the prior art.

Turning now to the references in particular to the patent to Delf, it can be that this reference does not disclose a spring element which on one hand is supported on the slaving element and on the other end is supported on the end-on part and in this manner axially fixes the add-on part. The patent to Delf discloses a compressible sealing disk 36 or 35 for vibration absorption. In column 3, lines 1-6 the patent to Delf discloses as follows:

"Preferably coextensive in area with the side faces of the center disk portions 14, and contiguous thereto, are a pair of compressibly resistant, cushioning and vibration-absorbent disks 35 and 36, the disks 35 engaging the rear side of the center disk 14 and the disk 36 the opposite or front face of the disk."

The disk 36 lies on the one hand on the add-on part 14, but on the other hand however lies on a cup-shaped element 25. The cup-shaped element 25, which receives the disk 36, lies in turn in an axial direction on a washer 37.

The patent Delf specifically explains in column 3, lines 23-26:

"Forwardly beyond the front cup 35 of the assembly is a washer 37, the openings through which is of a diameter such as to be passed over the small diameter portion 20 of the hub."

It is believed to be completely unacceptable to consider the combination of the three components 36, 25, 37 as a spring. This can be done only by exercising an unacceptable hindsight consideration of the U.S. patent, by a person who first of all familiarizes himself with the inventive features.

It is completely unclear how the washer 37 can be a component of a spring. There is no functional cooperation between the dampening or vibration absorbing disk 36 and the washer 37. They can not be combined with one another to form a single structural element such as a spring element.

If the dampening or vibration absorbing disk 37 can be interpreted as a spring, which of course is not logical and can not be considered as justified, this element would not be supported on the one hand on the slaving element and on the other hand on the add-on part, but instead as clearly disclosed in the patent to Delf, it will be supported on a cup-shaped receptacle 25.

The receptacle 25 has no spring functions whatsoever. Moreover, it serves however or enclosing the damping for absorbing disk 36 and thereby a squeezing of this disk out under the action of an excessive compression pressure. The receptacle 25 limits the elastic properties of the damping or absorbing disk 36 and can not be interrupted as a spring.

The patent to Delf in column 4, lines 9-16 further states:

"A particular advantage besides making for better appearance, of the cups 21 and 25, lies in the fact of virtually complete confinement of the resilient discs by the cups. It has been found that, unless a resilient disk or bushing is peripherally confined, peripheral extrusion or spread of such elements will often result in an out-of-balance condition, sometimes permitting spalling or destruction of such projecting parts."

The patent to Delf is completely silent about the spring action of the receptacle 25 either at this point or at any part of the reference. It is therefore believed that the Examiner's opinion related to the issue can not be considered as justified.

In accordance with the applicant's invention the device includes a simple spring element which is arranged in the certain way and cooperates with the corresponding elements in a new and inventive manner.

It is therefore believed that claim 13 together with claims 14, 16-20 and 22-24 define the features which can not be considered as disclosed in the patent to Delf. The same is true with respect to claim 25.

The original claims were rejected over this reference under 35 U.S.C. 102(b) as anticipated. In connection with this, it is believed to be advisable to cite the decision in *Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not contain all features of the present invention as defined in claim 13, in their specific order, with which their features interacting and interconnecting with one another. It is therefore believed that the original anticipation rejection should be considered as no longer tenable and should be withdrawn.

It should also be mentioned that the new features of the present invention as defined in claim 13 can not be considered as obvious from the patent to Delf. Since the patent Delf do not provide any hint or suggestion for such features, therefore in order to arrive at the applicant's invention from the teaching of this reference, the reference has to be

fundamentally modified by including into it the features which were first proposed by applicant.

It is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structural to one which prior art references do not suggest.

Definitely, the reference does not contain any hint or suggestion for such modification.

The Examiner's attention is respectfully directed to claim 26 which specifically defines that the spring element 16 is embodied in one piece. The one-piece spring element is not disclosed in the patent to Delf. Contrary to the Examiner's opinion expressed on page 4, last paragraph of the Office Action, such a design of the inventive device for securing an add-on part to a substantially smooth drive shaft is not disclosed in the

reference and can not be derived from it as a matter of obviousness. The patent to Delf specifically explains in column 4, lines 17-27:

"It is particularly preferred that the thickness of the discs 35-36 and the depth of the cups 21-25 be so selected that the inner margins of the flanges on the cups avoid contact with the spider disc or arms, a suitable spacing of these big parts shown by Figure 2. This arrangement prevents any direct vibration transmission path between the hub via the cups, into the spider or spider arms. The same result is furthered by forming the center aperture of the disc 14 larger than adjacent part of the hub and bridging these diameters with a non-metallic washer such as 31".

Thus, it is believed that the patent to Delf clearly emphasizes that there must be no direct vibration contact between the slaving element and the add-on part. When the spring element is formed as a one-piece element, exactly this vibration transmission is provided between the slaving element 14 and the add-on part 10. Therefore, a person of ordinary skill in the art who familiarize himself with the patent to Delf would not find any hint or suggestion for a spring element, in particular for a one-piece spring element, but instead must use a damping disk 35 which prevents the direct contact between the slaving element and the add-on part. The reference actually leads a person of ordinary skill away from the new features of the present invention.

It is therefore respectfully submitted that claim 26 should be considered as patentably distinguishing over the art and should be allowed.

Claim 27 defines that the add-on part has positive engagement with the slaving element and embraces it. The positive engagement of these two elements means that they are engaged so that the material of the add-on part of the material of the slaving element are in contact with one another. This is a standard meaning of the positive engagement. In the patent to Delf, as shown in Figure 2, in a radial direction there is an elastic element 31 between the slaving element 10 and the add-on part 14. The patent to Delf clearly explains in column 4, lines 24-47:

"The same result is furthered by forming the center aperture of the disc 14 larger than adjacent part of the hub and bridging these diameters with a non-metallic washer such as 31".

Thus, it is believed that the positive engagement of the add-on part and the slaving element is not disclosed in this reference, and moreover such a positive engagement must be avoided in all cases for suppressing a vibration transmission. The new features of the present

invention as defined in claim 27 therefore are not disclosed in this reference and can not be derived from it as a matter of obviousness. Not only the positive engagement is not mentioned in the patent to Delf, but it is clearly stated that it must be avoided, so that it is clear that the reference teaches away from the new features of the present invention as defined in claim 27.

Claim 27 should be considered as patentably distinguishing over the art and should be allowed.


As for the other claims, these claims depend on claim 13, they share their presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal aspects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the undersigned at (631-549-4700).

Respectfully submitted,



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